

REMARKS

In the application claims 1 – 16 remain pending. No claims have been canceled and no new claims have been added. Support for the claim amendments set forth above may be found in the specification, figures, and claims as originally filed. No new matter has been added.

All of pending claims presently stand rejected. The reconsideration of the rejection of the claims is, however, respectfully requested.

In the Office Action, the pending claims were rejected under 35 U.S.C. § 103 as being rendered obvious by Talib (U.S. Patent Application no. 2001/0044758) as modified by official notice, the teachings of Giovanolli (U.S. Patent No. 5,842,178), and/or the teachings of Hoffman (U.S. Patent No. 6,366,906). In rejecting the claims, the Office Action generally set forth that Talib discloses “the invention substantially as claimed” including a method for providing a customer with information regarding a product (citing to the Summary) including the steps of: receiving an electronic request for information for the product (citing to Para. 19, lines 4 – 5); searching a database to determine if the database contains information for the product (citing to Para. 19, lines 5 – 10); if the database contains information for the product, sending an electronic message to the customer containing selected information for the database corresponding to the product (citing to Para. 19, lines 10 – 15); and if information is not found for the product, performing a subsequent search to gather information for the product (citing to Figs. 10 and 11; Para. 120 – 146), sending the gathered information in an electronic message to the customer (citing to Para. 19), and adding gathered information to the database (citing to Para. 6). While the Office Action acknowledged that Talib fails to disclose, teach, or

suggest, among other things, a sourcing agent performing an off-line search, using an RFQ, or routing a request to perform a further search of a new database, the Office Action nevertheless concludes that it would have been obvious to modify Talib to include these missing claim elements. For example, the Office Action has taken official notice that sourcing agents are old and well known in the art and concludes that it would have been obvious to modify Talib to further include off-line searches for products because this would have made use of the specific skills of purchasing agents and improve the likelihood that the customer would receive the desired product information. The Office Action similarly asserts that Giovanolli discloses the use of RFQs and concludes that it would have been obvious to modify Talib to have a user prepare and forward an RFQ because this would have provided an option for a user to obtain a breadth of pricing information. Still further, the Office Action asserts that Hoffman discloses searching additional databases (citing to Fig. 7, element 718 and Col. 8, lines 45 – 58) and concludes that it would have been obvious to have broadened the product search disclosed by Talib because this would have given a greater search area and increased the likelihood that the customer would receive relevant information from subsequent searches.

In response to this rejection, it is respectfully submitted that an obviousness rejection under 35 U.S.C. § 103 may be maintained only if it can be demonstrated that: 1) the combination of prior art references disclose each and every element set forth in the claims, considering each and every word; and 2) an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have

selected the various elements from the references and combined them in the claimed manner.

With these requirements for maintaining a rejection under 35 U.S.C. § 103 in mind, it is submitted that Talib fails to “disclose the invention substantially as claimed.” Specifically, Talib is directed to a system for searching an electronic catalog that solves, among others, the problem of user frustration associated with a user searching for a product that does not exist within the product database (See Para. 29, lines 1 – 4). To solve this problem, Talib *only* allows a user to search for products that are already within the product database and which have been tagged with various taxonomy labels. In this manner, when a user enters a search query, the system of Talib presents to the user taxonomy categories relevant to the search term and the user may then select only from those presented taxonomy categories to further refine their search. By “pushing data back to the user,” the system of Talib does not allow for a user to specify a product that does not exist within the electronic catalog. (See Figs. 10 and 11, Paras. 120 – 146).

From the foregoing, it is evident that the system of Talib has been designed specifically for the purpose of preventing a user from searching for products that do not exist within an electronic catalog. Thus, it is submitted that Talib cannot be said to disclose the claimed “if the electronic database does not contain information for the product, performing a search outside of the electronic database to gather information for the product and sending the gathered information in an electronic message to the customer.” Still further, there is no disclosure, teaching, or suggestion concerning the claimed “adding the gathered information to the electronic database.” In this regard, there is no reason for Talib to include a step whereby information gathered outside of an

electronic database in response to a null search is added to the electronic database since Talib teaches a system wherein searches are limited to the products that are already contained within the electronic catalog.

It is further noted that it would not be obvious to modify Talib to arrive at the claimed invention. Specifically, since the modifications or combinations espoused in the Office Action would change the very principle of operation of Talib, i.e., to allow for searching outside of the stringently setup taxonomy of the electronic catalog, the teachings of the references are not sufficient to render the claims *prima facie* obvious. (See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Thus, for the reasons that Talib in combination with the references cited in the Office Action: 1) fail to disclose each and every element set forth in the claims; and 2) cannot be combined in the manner espoused in the Office Action to arrive at the claimed invention, the rejection of the claims must be withdrawn.

Still further, it is respectfully submitted that Hoffman also fails to disclose, teach, or suggest the claimed “automatic routing” of search requests to sourcing agents based upon a comparison between a search request and predetermined rules. Rather than disclose, teach, or suggest this claim element, Hoffman teaches a system in which a user *manually* sets up search criteria and then *manually* selects one of the search criteria to use. This is clearly in contradistinction to the claims.

More particularly, Hoffman describes a system in which a user manually specifies a search engine as a search tool, for example, the USPTO search engine. The *user may then select* the search tool to manually invoke the search engine that was manually specified by the user. (See Fig. 7; Col. 8, lines 33 – 67). Thus, while “a request for

patent information would sensibly determine the 'PTO Patent Search' engine," *the user* is required to make that sensible connection and then manually invoke the appropriate search tool. Hoffman does not describe, teach, or suggest a component that functions to automatically invoke a search engine given a search criteria and, for this reason, cannot be said to disclose, teach, or suggest modifying Talib in the manner set forth in the Office Action to thereby arrive at the claimed invention. For this additional reason, it is submitted that the rejection of the claims must be withdrawn.

CONCLUSION

The subject application is considered to be in condition for allowance. Such action on the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fee is due, the Commissioner is hereby authorized to charge any fee deficiency to deposit account number 50-2428 in the name of Greenberg Traurig.

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Respectfully Submitted

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